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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,653	12/08/2000	Junichi Yoshio	041465-5041-02	1574
9629	7590	01/12/2005	EXAMINER	
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			ONUAKU, CHRISTOPHER O	
			ART UNIT	PAPER NUMBER
			2616	

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/731,653	<b>Applicant(s)</b> YOSHIO ET AL.	
	<b>Examiner</b> Christopher O. Onuaku	<b>Art Unit</b> 2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 13-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/31/04</u> . | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 13 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 13 of U.S. Patent No. 6,215,952.

Regarding claim 13, claim 13 of the U.S. Patent No. 6,215,952 cite the features of claim 13 of this application including object information divided into a plurality of first data groups, each of the first data groups including an information record medium to be reproduced by an information reproducing apparatus, comprising: object information divided into a plurality of first data groups, each of the first data groups including control information; at least one second data group which comprises a plurality of said first data

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groups; and management information including reproduction procedure information prescribing a reproduction procedure of the object information, a plurality of operation prohibit information, each indicating a prohibition or a permission of a predetermined operation by the reproduction apparatus in response to a user's operation, is recorded at one position of a record track, and the number of reproduction operation control functions that a viewer can use to operate to change a state of reproduction once the reproduction of recorded material has begun is controlled by manufacturer-presets of the operation prohibit information (see lines 1-22).

Although the conflicting claims are not identical, the features of claim 13 of current application are obvious over the pertinent features of claim 13 of US Patent No. 6,215,952 because features of claim 13 of current application are broader and encompasses the pertinent features of claim 13 of US Patent No. 6,215,952.

3. Claim 14 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 14 of U.S. Patent No. 6,215,952.

Regarding claim 14, claim 14 of the U.S. Patent No. 6,215,952 cite the features of claim 14 of this application including wherein the plurality of first data groups contained in the at least one second data group are reproduced in accordance with the reproduction procedure information (see lines 1-3).

4. Claim 15 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 16 of U.S. Patent No. 6,215,952

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Regarding claim 15, claim 16 of the U.S. Patent No. 6,215,952 cite the features of claim 15 of this application including wherein one of the plurality of operation prohibit operation indicates a prohibition of search operation by the reproducing apparatus (see lines 1-4).

Although the conflicting claims are not identical, the features of claim 15 of current application are obvious over the pertinent features of claim 16 of US Patent No. 6,215,952 because features of claim 15 of current application are broader and encompasses the pertinent features of claim 16 of US Patent No. 6,215,952.

5. Claim 16 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 17 of U.S. Patent No. 6,215,952.

Regarding claim 16, claim 17 of the U.S. Patent No. 6,215,952 cite the features of claim 16 of this application including wherein wherein the object information is video information (see lines 1-2).

6. Claim 17 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 22 of U.S. Patent No. 6,215,952.

Regarding claim 17, claim 22 of the U.S. Patent No. 6,215,952 cite the features of claim 17 of this application including object information generating means for generating object information to be recorded; control information generating means for generating control information, a plurality of operation prohibit informations, each indicating a prohibition or a permission of a predetermined operation by the reproducing

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apparatus in response to a user's operation; management information generating means for generating management information including reproduction procedure information prescribing a reproduction procedure of the object information; record means for recording the object information and the control information such that the object information and the control information form a plurality of first data groups, and for recording the control (management) information at one portion of a record track at a location where no object information is recorded, wherein the number of reproduction operation control functions that a viewer can cause to operate to change a state of reproduction once the reproduction of recorded material has begun is controlled by manufacture-presets of the operation prohibit informations (see lines 5-28).

Although the conflicting claims are not identical, the features of claim 17 of current application are obvious over the pertinent features of claim 22 of US Patent No. 6,215,952 because features of claim 17 of current application are broader and encompasses the pertinent features of claim 22 of US Patent No. 6,215,952.

7. Claim 18 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 23 of U.S. Patent No. 6,215,952.

Regarding claim 18, claim 23 of the U.S. Patent No. 6,215,952 cite the features of claim 18 of this application including wherein the plurality of the first data groups forms a plurality of second data groups, and wherein the management information is generated for each of the plurality of the second data groups (see lines 1-4).

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8. Claim 19 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 25 of U.S. Patent No. 6,215,952.

Regarding claim 19, claim 25 of the U.S. Patent No. 6,215,952 cite the features of claim 19 of this application including wherein one of the plurality of operation prohibit information indicates a prohibition or a permission of search operation by the reproducing apparatus (see lines 1-4).

9. Claim 20 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 26 of U.S. Patent No. 6,215,952.

Regarding claim 20, claim 26 of the U.S. Patent No. 6,215,952 cite the features of claim 20 of this application including wherein the object information is video information (see lines 1-2).

10. Claim 21 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 31 of U.S. Patent No. 6,215,952.

Regarding claim 21, claim 31 of the U.S. Patent No. 6,215,952 cite the features of claim 21 of this application including object information divided into a plurality of first data groups each including control information; at least one second data group which comprises a plurality of said first data groups; and management information including reproduction procedure information prescribing a reproduction procedure of the object information, a plurality of operation prohibit information, each indicating a prohibition or a permission of a predetermined operation by the reproduction apparatus in response to

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a user's operation, is recorded at one position of a record track at a location where no object information is recorded, the apparatus comprising read means for reading information recorded on the record medium, reproduction means for reproducing the information read by the read means, instruction means for instructing the predetermined operation, detection means for detecting the management information from the information read by the read means and recorded at one portion at a location where no object information is recorded; and control means for permitting the predetermined operation when the operation prohibit information indicates that the operation is permitted and for prohibiting the predetermined operation when the operation prohibit information indicates that the operation is prohibited, wherein the number of reproduction operation control functions that a viewer can cause to operate to change a state of reproduction once the reproduction of the recorded material has begun is controlled by manufacture-presets of the operation prohibit information (see lines 4-40).

Although the conflicting claims are not identical, the features of claim 21 of current application are obvious over the pertinent features of claim 31 of US Patent No. 6,215,952 because features of claim 21 of current application are broader and encompasses the pertinent features of claim 31 of US Patent No. 6,215,952.

11. Claim 22 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 33 of U.S. Patent No. 6,215,952

Regarding claim 22, claim 33 of the U.S. Patent No. 6,215,952 cite the features of claim 22 of this application including wherein one of the plurality of operation prohibit



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operation indicates a prohibition or a permission of search operation by the reproducing apparatus (see lines 1-4).

Although the conflicting claims are not identical, the features of claim 22 of current application are obvious over the pertinent features of claim 33 of US Patent No. 6,215,952 because features of claim 22 of current application are broader and encompasses the pertinent features of claim 33 of US Patent No. 6,215,952.

12. Claim 23 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 34 of U.S. Patent No. 6,215,952.

Regarding claim 23, claim 34 of the U.S. Patent No. 6,215,952 cite the features of claim 23 of this application including wherein wherein the object information is video information (see lines 1-2).

### ***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher O. Onuaku whose telephone number is (703) 308-7555. The examiner can normally be reached on M-F 8:30-6:00.

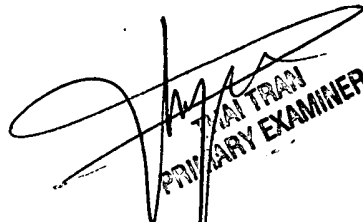
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on 703-305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
COO

12/31/04

  
PRIMARY EXAMINER